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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/046,592 | 01/14/2002 | R. Michael Gross | | 3738 |

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Dennis L. Thomte
THOMTE, MAZOUR & NIEBERGALL, L.L.C.
Suite 1111
2120 South 72nd Street
Omaha, NE 68124

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,592

Applicant(s)

GROSS, R. MICHAEL

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-12,14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 10 and 14 recite the "proximal end of said tube is shaped and sized to have a diameter greater than an intermediate portion of said tube" of which was not described in the written disclosure as to how this is evident of the tube. There are numerous ways the tube could have a "greater diameter" but the Applicant has not described any way in particular and as a result this is new matter. Additionally, claims 10 and 14 also recite the limitation that "said bend,..... being shaped and sized relative to said tube to substantially prevent unintended removal of said sleeve from said tube" of which was not described in the written disclosure as to how this is evident of the tube. There are numerous ways the tube could be "shaped and sized.....to prevent removal of the sleeve" but the Applicant has not described what is meant by this limitation and as a result this is new matter. Claims 11,12,15,16 are indefinite for depending from claims 10 and 14 respectively.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bogert et al. (5810785). Fig. 1d shows a tool having an elongated tube **16** with an outer surface and a proximal end that is capable of being in communication with a suction mechanism. It can also be seen that there is an elongated sleeve **10** and a gasket **26** to the distal end of the sleeve that permits sliding movement of the tube, col. 4, lines 60-63. It can be construed the distal end has a "sealing face" transverse to the long axis since the gasket is "sealed" to it. The gasket is fully capable of sealing engagement with the coracoid process. The use of "substantial portion of the sealing face" is terminology of relative degree, which has no basis of comparison. For this reason, it is considered broad and relatively unlimited and thus it can be said the gasket of Bogert is "substantially across a portion of the sealing face."

Claims 8,13 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverstein et al. (4646722). Fig. 1 shows a tool having an elongated tube **12** with an outer surface and an angular bend *adjacent* the distal end. It can also be seen (Fig. 2) there is a sleeve **48** that is slidably coupled (col. 4, lines 13-15) to the outer surface of the elongated tube and the sleeve forming a sealing surface that *is shaped and sized for* sealing engagement with bone.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4,8-11,13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrey et al. (5704909) in view of Silverstein et al. '722. Morrey et al. show (Fig. 5) a suction device for engaging bone having an elongated tube **57** and a gasket or disk 81 coupled to the exterior surface of the tube. Morrey discloses the device can be attached to a suction mechanism, col. 4, lines 29-31. Morrey discloses (Fig. 7) the distal end of the tube can have a plurality of openings **66**. Fig. 9 shows a bent distal end of the tube. Regarding claims 10 and 14, Fig. 16 shows the tube having a diameter (portion **120**) greater than an intermediate portion (the bend of the tube), which is adjacent the distal end **56** of the tube. However, Morrey et al. fail to disclose a sleeve coupled on the exterior of the tube. Silverstein et al. teach an outer sleeve or sheath can be slidably placed on the exterior of suction tubes, col. 3, lines 10-12. Silverstein also discloses the outer sleeve acts as a protective means for limiting interference of the surgical procedure, col. 3, lines 6-9. Silverstein shows (Figs. 1,2) the sleeve **48** has a sealing face transverse to a long axis of the sleeve. It would have been obvious to one of ordinary skill in the art to use a sleeve as taught by Silverstein with the tool of Morrey et al. such that it provides a more controlled environment in the procedure and would limit any interference during use of the tube.

Claims 5,12,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrey et al. '909 in view of Silverstein et al. '722 as applied to claims 1,11 and 15

respectively above, and further in view of Lee et al. (5693030). Morrey et al. in view of Silverstein et al. is explained supra. However, Morrey et al. as modified by Silverstein fail to disclose the tube uses an obturator. Lee teaches (Fig. 3) an obturator 60 that may be extended in the tube that is fully capable of clearing debris. It would have been obvious to one of ordinary skill in the art to permit the tube to be used with an obturator as taught by Lee et al. with the tool of Morrey as modified by Silverstein such that the obturator provides the ability of the surgeon to free up any debris accumulation that would block the flow of material being removed.

Response to Arguments

Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that the Bogert reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an undefined "sealing face" or a structural description of Applicant's sealing face) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that one of ordinary skill in the art would not have been motivated to combine the Bonutti and Morrey references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the comments are moot in view of the new combination of Morrey and Silverstein, but it is the Examiner's position that Morrey is combinable with other references as presented in the current office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

